



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,165	07/06/2000	John C. Calhoun JR.	5044:84	5604
7590	11/24/2003		EXAMINER	
Stanley R Moore Esq Jenkins & Gilchrist PC 1445 Ross Avenue Suite 3200 Dallas, TX 75202			FRENEL, VANEL	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/611,165

Applicant(s)

CALHOUN ET AL.

Examiner

Vanel Frenel

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 10 October 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/10/03 has been entered.

### **Notice to Applicant**

2. This communication is in response to the RCE filed 10/10/03. Claims 1, 12, 13 and 16 have been amended. Claims 1-20 are pending.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basic of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technology arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technology arts. More ideas, in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts to promote the “progress science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. Looking at claims 1-11 as a whole, nothing in the body of the claims recite any structure of functionality to suggest that a computer performs the recited steps.

Examiner respectfully requests a common usage such as “a computer readable-medium” or a “computer system” are well taken to be within the statutory categories within 35 U.S.C. 101 and therefore recommends using such terminologies.

As such, the above deficiencies may be cured by simply explicitly reciting that the claimed method /process steps are embodied or implemented on a “computer system” or on a “computer readable-medium” (as appropriate), provided Applicant show proper support for such recitations in the originally field specification.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rieker et al (5,832,447), Warady et al (6,067,522) in view of Myers (6,601,020).

(A) As per claim 1, Rieker discloses a database for use in a web-based managed care transaction system (Col.5, lines 25-67 to Col.6, line 12), comprising: a memory (See Rieker, Col.7, lines 59-67 to Col.8, line 24); and a set of data tables organized into a logical entity in the memory and including for each member (See Rieker, Col.8, lines 25-49): a set of one or more member history tables associated with the member table, each member history table associated with a given employer plan, wherein said logical entity is persistent over changes to each members' changes within said employer plan (See Warady, Col.4, lines 1-67 to Col.5, line 64).

Rieker and Warady do not collectively disclose a master account table including account setup information for at least one of utilization and login actions for said web-based managed care transaction system, a member table including identity information for at least one member.

However, these features are known in the art, as evidenced by Myers. In particular, Myers suggests a master account table including account setup information for at least one of utilization and login actions for said web-based managed care transaction system, a member table including identity information for at least one member (See Myers, Col.8, lines 28-67 to Col.9, line 40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Myers within the collective teachings of Rieker

and Warady with the motivation of providing a load test database which capable of storing login information, security information, captured user simulation scripts, and scenarios (See Myers, Col.3, lines 50-55).

(B) As per claim 2, Warady discloses the database wherein the set of data tables includes an employer table having associate therewith a set of one or more employer plan tables (Col.5, lines 1-54).

The motivation for combining the respective teachings of Rieker, Warady and Myers are as discussed above in the rejection of claim 1, and incorporated herein.

(C) As per claim 3, Warady discloses the database wherein a given employer plan table identifies a given employer plan (Col.5, lines 1-54).

The motivation for combining the respective teachings of Rieker, Warady and Myers are as discussed above in the rejection of claim 1, and incorporated herein.

(D) As per claim 4, Rieker discloses the database further including a managed care organization (MCO) table having associated therewith a set of one or more MCO product plan tables (Col.1, lines 15-67).

The motivation for combining the respective teachings of Rieker, Warady and Myers are as discussed above in the rejection of claim 1, and incorporated herein.

(E) As per claim 5, Warady discloses the database wherein a given MCO product plan table has associated therewith the set of one or more employer plan tables (Col.5, lines 1-54).

The motivation for combining the respective teachings of Rieker, Warady and Myers are as discussed above in the rejection of claim 1, and incorporated herein.

(F) As per claim 6, Warady discloses the database wherein a given member history table has associated therewith a set of one or more coordinated benefits tables (Col.5, lines 1-54).

The motivation for combining the respective teachings of Rieker, Warady and Myers are as discussed above in the rejection of claim 1, and incorporated herein.

(G) As per claim 7, Warady discloses the database wherein a given member history table has associated therewith a set of one or more assigned primary care physician (PCP) tables (Col.5, lines 1-54).

The motivation for combining the respective teachings of Rieker, Warady and Myers are as discussed above in the rejection of claim 1, and incorporated herein.

(H) As per claim 8, Warady discloses the database wherein an assigned PCP table has associated therewith a provider affiliation table (Col.5, lines 1-54).

The motivation for combining the respective teachings of Rieker, Warady and Myers are as discussed above in the rejection of claim 1, and incorporated herein.

(I) As per claim 9, Warady discloses the database wherein the set of data tables further includes a provider information table (Col.5, lines 1-54).

The motivation for combining the respective teachings of Rieker, Warady and Myers are as discussed above in the rejection of claim 1, and incorporated herein.

(J) As per claim 10, Warady discloses the database wherein the provider information table includes a set of one or more provider affiliation tables, a set of one or more hospital affiliation tables, and a set of one or more provider staff tables (Col.5, lines 1-54).

The motivation for combining the respective teachings of Rieker, Warady and Myers are as discussed above in the rejection of claim 1, and incorporated herein.

(K) As per claim 11, Warady discloses the database wherein the set of data tables includes a staging area table that includes data which tracks the member through various transaction events (Col.5, lines 42-67 to Col.6, line 11).

The motivation for combining the respective teachings of Rieker, Warady and Myers are as discussed above in the rejection of claim 1, and incorporated herein.

7. Claims 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rieker et al (5,832,447), Warady et al (6,067,522), Bessette (6,263,330) in view of Myers (6,601,020).

(L) As per claim 12, Rieker discloses a database for storing a set of data tables organized into a persistent logical entity wherein said logical entity maintains data on each member in spite of status changes and including for each member (See Rieker Col.7, lines 1-67): a set of one or more member history tables associated with the member table, each member history table associated with a given employer plan (See Warady Col.5, lines 6-54); a web-based managed care transaction system accessible over a computer network using a client browser, comprising a transaction server (See Bessette Col.14, lines 38-67 to Col.15, line 67).

Rieker , Warady and Bessette do not collectively disclose a master account table including account setup information for at least one of utilization and login actions for said web-based managed care transaction system, a member table including identity information for at least one member.

However, these features are known in the art, as evidenced by Myers. In particular, Myers suggests a master account table including account setup information for at least one of utilization and login actions for said web-based managed care transaction system, a member table including identity information for at least one member (See Myers, Col.8, lines 28-67 to Col.9, line 40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Myers within the collective teachings of Rieker, Warady and Bessette with the motivation of providing a load test database which capable of storing login information, security information, captured user simulation scripts, and scenarios (See Myers, Col.3, lines 50-55).

(A) As per claim 13, Rieker discloses a plurality of functional modules (Col.5, lines 25-67); a transaction processor (Col.5, lines 25-67); a managed care organization (MCO) subsystem interfaced to said transaction processor (Col.1, lines 15-67); a database wherein a logical entity retains data representative of users received healthcare within said database persistent across changes to a user's healthcare plan (See Warady, Col.4, lines 1-67 to Col.5, line 64); a network-based managed care system comprising a network-based server (See Fig.1; Col.6, lines 16-67); at least one client machine on which a graphical user interface operates (See Bessette, Fig.1; Col.6, lines 16-67); a network-based subsystem comprising: a multiplexer (The Examiner interprets interfaces 702, 704 and 706 to be a form of multiplexer Col.9, lines 17-60).

The collective teachings of Rieker, Warady and Bessette do not explicitly disclose said database including a master account table for retaining account setup information for at least one of utilization and login actions for said web-based managed transaction system, and a member table including identity information for at least one member.

However, these features are known in the art, as evidenced by Myers. In particular, Myers suggests said database including a master account table for retaining account setup information for at least one of utilization and login actions for said web-based managed transaction system, and a member table including identity information for at least one member (See Myers, Col.8, lines 28-67 to Col.9, line 40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Myers within the collective teachings of Rieker,

Warady and Bessette with the motivation of providing a load test database which capable of storing login information, security information, captured user simulation scripts, and scenarios (See Myers, Col.3, lines 50-55).

(B) As per claim 14, Rieker discloses the network-based managed care system wherein said functional modules comprise: an enrollment module (Fig.10A (item 1); billing module (Fig.10A (item 2); messaging module (Fig.10B (items 79-81); and inquiry module (Fig.10B (item 79).

(C) As per claim 15, Warady discloses the network-based managed care system wherein changes to a user's health plan occur as a user changes employment (See Warady, Col.4, lines 1-67 to Col.5, line 64).

The motivation for combining the respective teachings of Rieker, Warady, Bessette and Myers are as discussed above in the rejection of claims 1, 12 and 13 and incorporated herein.

(D) As per claim 16, Warady discloses the network-based managed care system wherein changes to a user's health plan occur as a user changes their healthcare plan (See Warady, Col.4, lines 1-67 to Col.5, line 64).

The motivation for combining the respective teachings of Rieker, Warady, Bessette and Myers are as discussed above in the rejection of claims 1, 12 and 13 and incorporated herein.

(E) As per claim 17, Bessette discloses the network-based managed care system wherein the network comprises an Internet (Col.1, lines 15-35).

The motivation for combining the respective teachings of Rieker, Warady, Bessette and Myers are as discussed above in the rejection of claims 1, 12 and 13 and incorporated herein.

(F) As per claim 18, Warady discloses the network-based managed care system wherein said the database contains a historical record of care provided to said user (Col.10, lines 42-67).

The motivation for combining the respective teachings of Rieker, Warady, Bessette and Myers are as discussed above in the rejection of claims 1, 12 and 13 and incorporated herein.

(G) As per claim 19, Warady discloses the network-based managed care system wherein said persistent logical entity comprises a healthcare administrative record (Col.4, lines 1-20).

The motivation for combining the respective teachings of Rieker, Warady Bessette and Myers are as discussed above in the rejection of claims 1, 12 and 13 and incorporated herein.

(H) As per claim 20, Warady discloses the network-based managed care system wherein said persistent logical entity spans a user's change in employment plans (Col.5, lines 65-67 to Col.6, line 53).

The motivation for combining the respective teachings of Rieker, Warady, Bessette and Myers are as discussed above in the rejection of claims 1, 12 and 13 and incorporated herein.

### ***Response to Arguments***

8. Applicant's arguments filed 10/10/03 regarding claims 1-12, 13 and 16 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in order in which they appear in the response filed 10/10/03.

(A) At pages 7-9 of the 10/10/03 response Applicant argues that the features in the 10/10/03 amendment are not taught by or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 10/10/03 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Rieker, Warady, Besette and/or Myers based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the

invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 9), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches system for web-based payroll and benefits administration (6,401,079), distributed access management of information resources (6,182,142) and system and method for improving efficiency of health care (US 2002/0077849).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:30am-5:00pm.

Art Unit: 3626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F  
V.F

November 17, 2003

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600